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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,779	04/21/2004	Robert P. Bourdelais	85924PAL	5242

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/828,779

Applicant(s)

BOURDELAIS ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 20-24 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/21/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 - 19, drawn to a label stock, classified in class 428, subclass 40.1.
  - II. Claims 20 - 24, drawn to a method of forming labels, classified in class 408, subclass 700.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II, claims 20 - 24 and Group I, claims 1 - 19 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product such a sheet of paper being cut into postcards containing perforations for separation.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Paul Leipold on October 20, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 - 19.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 20 – 24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 – 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 49 of copending Application No. 10/780,263. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim an article having a base made of a compliant material, a closed cell foam core sheet, having an adhesive layer and a sheet that accepts printing.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1 – 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 41 of copending Application No. 10/783,411. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim an article having a base made of a compliant material, a closed cell foam core sheet, having an adhesive layer and a sheet that accepts printing.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claims 1 – 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “compliant carrier sheet” in claims 1 – 11, 18 and 19 is unclear, which render the claims vague and indefinite. Both the specification and the claim language are unclear concerning what makes the “compliant carrier sheet”. Paragraph 0039 of the specification defines the carrier sheet has an air voided polymer layer made through the use of a void initiating material (Paragraph 0040) or a chemical blowing agent (Paragraph 0046). Does this mean that it is a polymer film containing voids, or does a closed or open celled foam material read upon the “compliant carrier sheet”? What is the construction of the sheet?

Claims 12 – 17 are also rejected under 35 U.S.C. 112 2<sup>nd</sup> paragraph due to their dependency on the above rejected claims.

Correction/clarification is required.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1 – 4, 6, 8 – 12 and 14 – 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoki et al. (USPGPub 2002/0004117 A1).

Aoki et al. discloses a label stock (Paragraph 0005) comprising in order at least one pragmatic sheet (Figures 1 – 3, #1), a pressure sensitive adhesive (Paragraph 0032; Figure 1, #2) having a thickness between 5 and 100 micrometers, thereby overlapping the claimed range of 12 and 25 micrometers, (Paragraph 0049) and a compliant carrier sheet (Figures 1 – 3, #3), wherein the compliant carrier sheet comprises at least one voided layer (Paragraph 0028 – wherein the cells of the foam layer are equivalent to the voids) adjacent said adhesive (Figure 1, #2 and 3; Paragraph 0046) as in claims 1, 4, 6 and 12. Regarding claims 2, 3 and 8 – 11, the compliant carrier sheet would inherent recover to 90% of the original thickness after compression of between 25 and 50% of the original thickness, recover 95% of the original thickness in less than 2 seconds after removal of load, having a compliant factor of between 20 and 100 micrometers measured at 1.2 MPa, have a modulus of at least 2500 MPa, be reflective to collimated light energy and have a surface resistivity of less than 10<sup>12</sup> ohms per square since the compliant is an air voided polymer layer (Paragraph 0028 – wherein the cells of the foam layer are equivalent to the voids). The pragmatic sheet comprises either cellulose paper or is

substantially transparent (Paragraph 0031) and would inherently have a bulk modulus of 2000 to 100,000 MPa.

13. Claims 1 – 4, 6, 8 – 12 and 14 – 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Aoki et al. (USPN 6,562,429).

Aoki et al. discloses a label stock (Column 1, lines 30 – 33) comprising in order at least one pragmatic sheet (Figures 1 – 3, #1), a pressure sensitive adhesive (Column 3, lines 29 – 31; Figure 1, #2) having a thickness between 5 and 100 micrometers, thereby overlapping the claimed range of 12 and 25 micrometers, (Column 7, lines 11 – 14) and a compliant carrier sheet (Figures 1 – 3, #3), wherein the compliant carrier sheet comprises at least one voided layer (Column 2, lines 41 – 42 – wherein the cells of the foam layer are equivalent to the voids) adjacent said adhesive (Figure 1, #2 and 3; Column 6, lines 40 – 43) as in claims 1, 4, 6 and 12. Regarding claims 2, 3 and 8 – 11, the compliant carrier sheet would inherent recover to 90% of the original thickness after compression of between 25 and 50% of the original thickness, recover 95% of the original thickness in less than 2 seconds after removal of load, having a compliant factor of between 20 and 100 micrometers measured at 1.2 MPa, have a modulus of at least 2500 MPa, be reflective to collimated light energy and have a surface resistivity of less than 1012 ohms per square since the compliant is an air voided polymer layer (Column 2, lines 41 – 42 – wherein the cells of the foam layer are equivalent to the voids). The pragmatic sheet comprises either cellulose paper or is substantially transparent (Column 3, lines 18 – 25) and would inherently have a bulk modulus of 2000 to 100,000 MPa.



***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5, 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. (USPN 6,562,429) in view of Reiger et al. (USPN 6,653,061).

Aoki et al. discloses a label stock (Column 1, lines 30 – 33) comprising in order at least one pragmatic sheet (Figures 1 – 3, #1), a pressure sensitive adhesive (Column 3, lines 29 – 31; Figure 1, #2) having a thickness between 5 and 100 micrometers, thereby overlapping the claimed range of 12 and 25 micrometers, (Column 7, lines 11 – 14) and a compliant carrier sheet (Figures 1 – 3, #3), wherein the compliant carrier sheet comprises at least one voided layer (Column 2, lines 41 – 42 – wherein the cells of the foam layer are equivalent to the voids) adjacent said adhesive (Figure 1, #2 and 3; Column 6, lines 40 – 43) as in claims 1, 4, 6 and 12. Regarding claims 2, 3 and 8 – 11, the compliant carrier sheet would inherent recover to 90% of the original thickness after compression of between 25 and 50% of the original thickness, recover 95% of the original thickness in less than 2 seconds after removal of load, having a compliant factor of between 20 and 100 micrometers measured at 1.2 MPa, have a modulus of at least 2500 MPa, be reflective to collimated light energy and have a surface resistivity of less than 10<sup>12</sup> ohms per square since the compliant is an air voided polymer layer (Column 2, lines 41 – 42 – wherein the cells of the foam layer are equivalent to the voids). The pragmatic sheet

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comprises either cellulose paper or is substantially transparent (Column 3, lines 18 – 25) and would inherently have a bulk modulus of 2000 to 100,000 MPa. However, Aoki et al. fail to disclose a polyester polymer sheet having at least one voided layer, a release layer between said adhesive and said voided layer and the pragmatic sheet comprising a gelatin layer adjacent to said adhesive.

Reiger et al. teach a polyester polymer sheet (Column 10, lines 10 – 13) having at least one voided layer (Column 10, lines 66 to Column 11, line 11), a release layer between said adhesive (Column 18, lines 19 – 27) and said voided layer and the pragmatic sheet comprising a gelatin layer adjacent to said adhesive (Column 7, lines 9 – 17) in a label stock (Column 1, lines 6 – 9) for the purpose of forming a label that is low in cost and has excellent optical properties (Column 10, line 66 to Column 11, line 1).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polyester polymer sheet and gelatin layer in Aoki et al. in order to form a label that is low in cost and has excellent optical properties as taught by Reiger et al.

16. Claim s 13, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. (USPN 6,562,429) in view of Tsugawa et al. (USPN 5,928,987).

Aoki et al. discloses a label stock.(Column 1, lines 30 – 33) comprising in order at least

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one pragmatic sheet (Figures 1 – 3, #1), a pressure sensitive adhesive (Column 3, lines 29 – 31; Figure 1, #2) having a thickness between 5 and 100 micrometers, thereby overlapping the claimed range of 12 and 25 micrometers, (Column 7, lines 11 – 14) and a compliant carrier sheet (Figures 1 – 3, #3), wherein the compliant carrier sheet comprises at least one voided layer (Column 2, lines 41 – 42 – wherein the cells of the foam layer are equivalent to the voids) adjacent said adhesive (Figure 1, #2 and 3; Column 6, lines 40 – 43). However, Aoki et al. fail to disclose the pragmatic sheet comprising a thermal dye receiver layer or an ink jet receiver layer.

Tsugawa et al. teach a pragmatic sheet comprising a thermal dye receiver layer (Column 7, lines 4 – 6; Column 2, lines 42 – 47) or an ink jet receiver layer (Column 6, lines 63 – 66) in a label stock (Column 7, line 5) for the purpose of forming a recording material that is superior in sensitivity and image durability while having good resistance to heat and moisture (Column 2, lines 22 – 25).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the thermal dye receiver layer or ink jet receiver layer in Aoki et al. in order to form a recording material that is superior in sensitivity and image durability while having good resistance to heat and moisture as taught by Tsugawa et al.

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***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

  
pln

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
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2/3/06